# REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application in view of the amendments and the remarks to follow. Claims 1-24, 34-44 and 49 were previously canceled and new claims 65-72 have been added. Claims 25-33, 45-48 and 50-72 are pending in this application. Reconsideration of the application is requested in view of the amendments and the remarks to follow.

New claims 65-72 are supported at least by text appearing at page 4, line 2 through page 46, line 15 of the substitute application, which corresponds to the application as originally filed. No new matter is added by new claims 65 et seq. New claims 65 et seq. distinguish over the art of record and are allowable.

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## 35 U.S.C. § 103

Claims 25-32 and 45-48 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,837,635 to Santos et al. (hereinafter "Santos") in view of the IBM Technical Disclosure Bulletin entitled "Host System and Attached Non-Programmable Terminal with Open Parallel Port" (hereinafter "IBM"). Claim 33 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Santos in view of IBM and further in view of U.S. Patent No. 5,796,945 to Tarabella (hereinafter "Tarabella"). Claims 50-57 and 59-64 stand rejected under 35 U.S.C. §103(a) as being unpatentable over newly-cited U.S. Patent No. 6,587,129B1 to Lavendel et al. (hereinafter "Lavendel") in view of IBM. Claim 58 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Lavendel in view of IBM and further in view of Tarabella. Applicant respectfully disagrees and requests reconsideration.

Santos is directed (see, e.g., Title) to "A scanning system in which a portion of a preview scan image of a picture displaced on a screen is selected and a corresponding portion of the picture is scanned in a final scan". Santos teaches (see Abstract) that: "An improved scanner is presented which enables a user to preview scan a picture and set out on a screen exactly what portion of the picture he desires to scan. The scanner allows a preview scan of the picture to be made. The preview scan presents a preview image. The user is able to specify what portion of the picture he wants by enclosing that portion of the preview image in a box. Then the scanner performs a final scan which scans only the specified portion of the picture. When performing the final scan, the user may select a percentage amount to reduce or enlarge the image when printed as a printed copy.

As the user changes the percentage amount, the dimensions of the resulting printed copy are displayed. The dimensions are calculated by determining the dimensions of the portion to be scanned, and reducing or enlarging the dimensions proportionate to the amount the printed copy is reduced or enlarged."

IBM is directed (see abstract) to a method for providing a host system with an application program interface for an open parallel port and an attached non-programmable terminal (NPT) which has an open parallel port.

In contrast, claim 25 recites "For a computer-implemented scanning system having a scanner coupled to a computer, a user interface comprising a graphical window having a preview scan space, the preview scan space being initially empty prior to a time when the scanner scans an image, the user interface progressively displaying the image within the preview scan space to visually convey that the scanner is scanning the image", while claim 45 recites "For a computer-implemented scanning system having a scanner coupled to a computer, a computer-implemented method for executing a scanning software application in a graphical user interface windowing environment, comprising the following steps: presenting a preview scan space within a graphical window, the preview scan space being initially empty; and progressively displaying an image within the preview scan space to visually convey that the scanner is scanning the image", which is not taught, disclosed, suggested or motivated by Santos or IBM in any proper combination.

The Office Action admits (p. 5) that Santos does not teach an interface that progressively displays an image within a preview scan space. The Office Action also states (p. 2, *Response to Arguments*) that "In response, Santos discloses a

user interface having a graphical window having a preview scan space, which is
empty prior to a time when the scanner scans an image (figs. 1-7)." The Office
Action further states (page 3) that "In response, the preview scan space displays a
preview image after the user selects preview scan in menu 42 of window 44,
which is empty prior to the user's selection (figs. 4-6)." (emphasis added). Santos
does not show most of the preview scan space 44 in the Figs. The portions shown
are not empty prior to the user's selection and the text of Santos is inconsistent
with the allegations contained in the Office Action.

More specifically, Figs. 4 through 6 are discussed at col. 3, line 30 et seq.,
stating that:

> FIGS. 4-11 demonstrate how a user would perform a preview
> scan and a final scan according to the preferred embodiment of the
> present invention.
>
> In FIG. 4, a scan window 44 appears on the screen of monitor
> 14. Movement of a cursor 41 corresponds to movement of mouse 20
> on a flat surface. A menu bar 42 appears at the top of window 44. A
> user brings up a pull down menu 43, by stationing cursor 41 over
> "Scan" in menu bar 42. Then user depresses button 27 on mouse 20.
> In order to perform a preview scan of a picture 15 on scanner
> hardware 13, the user must station cursor 41 over "Preview Scan" in
> pull down menu 43, and then release button 27.
>
> Upon release of button 27, dialog box 51 appears on monitor
> 14, as shown in FIG. 5. Using mouse 20, the user may adjust the
> intensity of the scan of the original, and may indicate that the
> original includes shades of gray or shades of color.
>
> Once the user is satisfied with his selections, he places cursor
> 41 over region 52. Upon pressing and releasing button 27, a preview
> scan is performed and image 61 appears on monitor 14, as shown in
> FIG. 6.
>
> In order to perform a final scan, cursor 41 is placed in a
> position on window 44 as shown in FIG. 6. Button 27 is depressed
> on mouse 20, and as mouse 20 is used to move cursor 41 across the
> screen of monitor 14, a selection box 71 appears as shown in FIG. 7.

Selection box 71 is a rectangle. The upper left corner is at the spot where button 27 was depressed. The lower right corner follows cursor 41, as long as user continues to depress button 27. Once the user releases button 27, the position of the lower right corner becomes fixed. The size of selection box 71 may be adjusted by placing cursor, over one of handles 72, depressing button 27, moving cursor 41 to a new location and releasing button 27. The location of selection box 71 may be adjusted by placing cursor 41 inside selection box 71, depressing button 27, and moving mouse 20 until selection box 71 is positioned appropriately. Selection box 71 may be made to disappear by placing cursor 41 outside and depressing and releasing button 27.

In order to perform a final scan, a user brings up a pull down menu 43, by stationing cursor 41 over "Scan" in menu bar 42. See FIG. 4. Then user depresses button 27 on mouse 20. The user must station cursor 41 over "Final Scan" in pull down menu 43, and then release button 27.

The window 44 initially has menu bar 42 and pull-down menu 43 within it. The window 44 then has dialog box 51 and region 52 in it, still prior to initiation of any preview scan.

IBM does not cure these deficiencies. IBM is silent regarding mode of display and that text relating to scan technology referenced within the Office Action merely states:

(p. 475, 1$^{ST}$ paragraph) "Image scanner extensions are also supplied."

(p. 475, last paragraph) "When the user requests an image scan, the host application could fill in a data structure with the following: where to store the image on the host system, maximum size of the image data, scanner type, resolution, and x/y end points of the scan."

(p. 476, lines 2 and 3) "The image scanner API program builds a display data stream based on the content of the data structure."

(p. 476, lines 18 and 19) "When all of the image data has been received, the API program could write the image to a file on the host if requested to do so, fill in

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the actual size of the image (which may have been truncated), and return to the calling application."

(p. 477, lines 16 and 17) "The WSC could also receive an event which indicates that the user has cancelled the image scan from Local Scanner Preview Mode."

(p. 478, lines 22 through 25) "The NPT could support a low-resolution Local Scanner Preview mode. Data from the scanner could be displayed in an Online Setup Mode screen so the user can view the scanned image as the compressed data is passed to the WSC. The preview menu could also include Cancel Scan pushbutton which will allow the user to cancel scan processing."

The Office Action states (p. 2) that "IBM teaches that data from a scanner could be displayed so the user can view the scanned image as the compressed data is passed to the workstation controller (progressively displaying the image within the preview scan space to visually convey that the scanner is scanning the image), (page 478, lines 22-25)." However, IBM is silent regarding any progressive display of anything, and also is silent regarding any visual conveyance of scanning activity. There is simply nothing in these passages that teaches, discloses, suggests or motivates "progressively displaying the image within the preview scan space to visually convey that the scanner is scanning the image", as recited in claims 25 and 45.

The Office Action further states (page 3) that "In response, IBM discloses an image scanning application programming interface (API) that can be added on a host system; the host application enabled to have a menu where the user initiates image scanning. IBM teaches a Preview Mode, wherein data from the scanner

could be displayed in an Online Setup Mode Screen so that the user can view the scanned image as the compressed data is passed to the work station controllers (WSC). (pages 475 and 478)." This passage is completely silent regarding any progressive display of anything, and also is silent regarding any visual conveyance of scanning activity. Display of a low-resolution scanner preview image, as described by IBM, fails to teach, disclose, suggest or motivate the affirmatively-recited subject matter of claims 25 and 45.

IBM indicates (page 478) that "The NPT could support multiple display sessions. A user could initiate an image scan in one session (which could take a while for a multi-page document on a scanner with a sheet feeder). Then the user could switch to a different session to do other host work while the image scanning is in progress."

Why would IBM teach that the user could switch to other tasks while scanning was in progress if IBM provided any indication of scan progress to the user? IBM provides no teaching of why or how any "user interface progressively displaying the image within the preview scan space to visually convey that the scanner is scanning the image" might be effectuated in the context of scanning a multi-page document with a sheet feeder or of how such might be employed or even why one might employ such a feature.

Why would IBM provide such teaching if IBM even contemplated the subject matter of claims 25 and 45? There is no discussion identified in IBM by the Office Actions of any affirmative indication of scanning progress.

Tarabella is directed (Title) to: "Idle time multimedia viewer method and apparatus for collecting and displaying information according to user defined indicia". Tarabella describes (Abstract): "An apparatus for collecting a series of image collections for display on a video terminal at a user-selected time and sequence, with the series of image collections selected according to a user-defined indicia of images to collect. The apparatus includes means for generating a set of indicia used to select and create sets of image collections for subsequent display on a video terminal at a user-selected time and sequence; means for collecting sets of image collections based on the set of indicia; and means for displaying representative portions of each of the sets of image collections on the video terminal. Means are provided for displaying the sets of image collections."

In contrast, claim 33, as amended, recites "A browser embodied on a computer-readable medium, incorporating a user interface for a computer-implemented scanning system having a scanner coupled to a computer, the user interface comprising a graphical window having a preview scan space, the preview scan space being initially empty prior to a time when the scanner scans an image, the user interface progressively displaying the image within the preview scan space to visually convey that the scanner is scanning the image", which is not taught, disclosed, suggested or motivated by the cited references.

As noted above, Santos and IBM fail to provide the elements that they are cited for. Tarabella fails to cure these deficiencies. Tarabella is not concerned with scan preview and in fact is void of the term "scan". As such, Tarabella provides no motivation for the subject matter of claim 33. The statement in the

Office Action (page 7) that motivation "because, as Tarabella says, the browser enables the user to access commercial information networks" has no logical relationship whatsoever to the subject matter of claim 33. Clarification of the rejection is requested.

Lavendel is directed (see, e.g., Title) to a "user interface for image acquisition devices". Lavendel describes (see Abstract): "A user interface for image acquisition devices that provides common control of common features of different image acquisition devices while retaining the flexibility needed to provide tailored control that take advantage of unique features of each different image acquisition device. The user interface includes a control area for displaying a property sheet. The property sheet has a plurality of property pages, each of which has an interface for image acquisition device control and each of which has a tab describing the control provided by that property page. At least one property page has an interface for core image acquisition device control, and at least one property page has an interface for device-dependent image acquisition device control. The user interface also provides a property sheet with a property page that attractively provides plural interfaces for control in that property page. The property page includes a control region for providing control and a button region having multiple buttons. An appearance of the control region is changed in response to user manipulation of the multiple buttons, with each different appearance providing a different interface for the control."

The Office Action states (page 7) that Lavendel discloses "the preview scan space being initially empty prior to a time when the scanner scans an image". Applicant finds no such teaching in Lavendel. The Office Action does not identify

where such teaching or disclosure might be found. Clarification of the rejection is requested.

The Office Action relies on IBM for teachings relative to providing "the user interface progressively displaying the image within the preview scan space to visually convey that the scanner is scanning the image" as recited in claim 50, "progressively displaying an image within the preview scan space to visually convey that the scanner is scanning the image", as recited in claim 59 and "the user interface progressively displaying the image within the preview scan space to visually convey that the scanner is scanning the image", as recited in claim 63.

As noted above, IBM does not provide any such teaching. As a result, combining the teachings of Lavendel and IBM fails to provide the elements recited in claims 50, 59 and 63.

Claim 58, as amended, recites "A browser embodied on a computer-readable medium incorporating user interface for a computer-implemented scanning system having a scanner coupled to a computer, the user interface comprising: a graphical window including a context space and a menu and toolbar area, the context space being separate from the menu and tool bar area; a preview scan space within the context space, the preview scan space being initially empty prior to a time when the scanner scans an image, the user interface progressively displaying the image within the preview scan space to visually convey that the scanner is scanning the image; and a persistently-visible, context-specific menu positioned adjacent the preview scan space within the context space", which is not taught, disclosed, suggested or motivated by the cited references.

As noted above, combining the teachings of Lavendel and IBM fails to provide the elements relied on in the rejection. Tarabella does not cure these deficiencies.

With respect to all of the unpatentability rejections, Applicant notes the requirements of MPEP §2143, entitled "Basic Requirements of a Prima Facie Case of Obviousness" (see also MPEP §706.02(j), entitled "Contents of a 35 U.S.C. 103 Rejection."). MPEP §2143 states that "To establish a prima facie case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." Inasmuch as the references fail to teach or disclose the elements recited in the claims, the references cannot provide motivation to modify their teachings to arrive at the invention as claimed, and the Examiner has identified no such teaching or disclosure in the reference. As a result, the first prong of the test cannot be met.

MPEP §2143 further states that "Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

Inasmuch as the reference fails to provide all of the features recited in Applicant's claims, the third prong of the test is not met. As a result, there cannot be a reasonable expectation of success. As such, the second prong of the test cannot be met.

MPEP §2143 additionally states that "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be

found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." This fourth criterion cannot be met because the references fail to teach or disclose the elements recited in the claims.

The statement (page 5) that the subject matter of Applicant's claims "would have been obvious" because "it enables the user to see in real-time what the imaging device is capturing and cancel scan processing if desired" is completely unsupported by the cited references. As such, it must be impermissible hindsight reconstruction based on Applicant's own disclosure.

The Examiner is reminded that hindsight reconstruction is not an appropriate basis for a §103 rejection. *(See, e.g., Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990) (explaining that hindsight reconstruction is an improper basis for rejection of a claim).)

Claims 26-32, 46-48, 51-57, 60-62 and 64 also distinguish by virtue of dependence from allowable claims and for their recitations which are neither taught nor disclosed by the cited references. The unpatentability rejection of claims 25-33, 45-48 and 50-64 thus fails the tests noted above. As a result, the rejection of claims 25-33, 45-48 and 50-64 is clearly prima facie defective and should be withdrawn, and claims 25-33, 45-48 and 50-64 should be allowed.

## Conclusion

Claims 25-33, 45-48 and 50-72 are in condition for allowance. Applicant respectfully requests reconsideration and issuance of the subject application. Should any matter in this case remain unresolved, the undersigned attorney respectfully requests a telephone conference with the Examiner to resolve any such outstanding matter.

Respectfully Submitted,

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